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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,057	08/30/1999	MICHAEL RUFFIN	PO9-98-157H	9966

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EXAMINER	
WOO, RICHARD SUKYOON	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/386,057	RUFFIN ET AL.	
	Examiner	Art Unit	
	Richard Woo	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-29 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-29 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1) The Applicant's amendment filed July 7, 2004 has been acknowledged and entered.

2) Applicant's arguments filed July 7, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the Claim 1 has been amended to overcome the rejection under 35 U.S.C. § 101, this is respectfully traversed by the examiner. Although the preamble of the Claim 1 cites "... in a data processing system", the applicant fails to incorporate or implement this data processing system into the main claim body to execute the method for determining a cost. The examiner may invite the applicant's attention to the corresponding rejection under 35 U.S.C. § 101 from the prior office action.

In response to the applicant's argument that the Claim 15 is specifically directed to a "program product", the examiner also agrees to this notion because it transforms electrical signals inside of the computer and is "concrete and tangible." However, the epitome of the rejection under 35 U.S.C. § 101 of the previous office action is based on the failure of "utility" requirement under 35 U.S.C. § 101. The Claim 15 is directed to an abstract idea to deriving a cost and capacity measurement that can be carried out by mere human intervention. For example, any person skilled in the art could derive the cost and the measurement by receiving information on usage for computer platforms; determining a required processing capacity for the platforms (by looking up the table or

manually searching the database); deriving a cost and measurement for each platform; determining an amount of the required processing capacity (by similar procedure as cited above); and finally deriving a cost and capacity measurement. Although the program product itself could be concrete and tangible, it may fail to satisfy the "utility" requirement if it merely contains the steps that involve human mental process and does not transform data corresponding to something in the real world. Although the Claim 15 is directed to the program product, the applicant fails to incorporate or implement this data processing system into the main claim body to execute the steps for determining a cost and measurement.

In response to the applicant's argument that merely switching computers is not the same thing as switching computer platforms and further theses are entirely different concepts, the examiner respectfully suggest that the applicant elaborate this difference by citing the pertinent section from the applicant's disclosure so as to result in **a structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

4) Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Please see the previous office action and the above examiner's response to the applicant's arguments.

Claim Rejections - 35 USC § 102

5) Claim 29 is rejected under 35 U.S.C. 102(e) as being anticipated by Robertazzi et al..

Robertazzi et al. discloses an apparatus:

a storage base (115);

means for determining (103), processing capacity for first and second computers;

means for deriving a cost and capacity measurement for platforms (see Figs. 1-6 and the descriptions thereof);

means for partitioning the processing capacity of computer platforms (se Figs. 5-7 and the description thereof); and

means for deriving a cost and capacity measurement for the first computer platform (see Figs. 1-7).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Richard Woo
Patent Examiner
GAU 3629
October 12, 2004

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600